



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/733,027 12/11/2003 Alexander V. Lubnin 20ICT033A 7489

37535 7590 02/07/2007
LEGAL DEPARTMENT
NOVEON, INC.
9911 BRECKSVILLE ROAD
CLEVELAND, OH 44141-3247

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
----------	--------------

1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS 02/07/2007 PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/733,027	Applicant(s) LUBNIN ET AL.	
	Examiner Patrick D. Niland	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/10/07.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37, 47-49, 55 and 60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-37, 47, 49, 55 and 60 is/are rejected.
- 7) ☒ Claim(s) 14 and 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1714

1. The finality of the office action of 9/11/06 is withdrawn in view of the new grounds of rejection.

2. Claim 60 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim

1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 47 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 3-167286 Sunstar Giken KK (English abstract referenced).

Sunstar discloses making mixtures of polyurethane prepolymers with terminal NCO groups which fall within the scope of the methods of the instant claims 47 and 55. The prepolymers were clearly individually made or else the components would have clearly co-reacted rather than make the specified prepolymers. Since the polymers are different, their hydrophilicities will necessarily be different which reads on claim 47.

5. Claims 47 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4999407 Gilch et al..

Art Unit: 1714

Gilch discloses the method of the instant claims at column 3, lines 35-68 and column 4, lines 1-28. Since the polymers are different, their hydrophilicities will necessarily be different which reads on claim 47.

6. Claims 1-13, 15-37, 47, 49, 55, and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5959003 Lo et al.

Lo discloses making polyurethane prepolymers which are NCO terminated as evidenced by their ability to be chain extended and the referenced free NCO groups and the common usage of "prepolymer" such that there are two different hydrophilicity prepolymers made separately from each other and the mixture thereof is dispersed in water so as to give core shell particles as described. "Together dispersed in water" of the abstract and "together dispersed into deionized water" of column 3, lines 24-25 and the fact that core shell structures form are taken as clearly indicating that the prepolymers are mixed together before dispersing them in water. See the abstract; column 2, lines 1-67, particularly 1-30 and 49-57 which encompasses the different acid numbers of the instant claims, more particularly lines 8-12; column 3, lines 1-67, particularly 6-32; column 4, lines 1-67; column 5, lines 1-65, particularly claims 1, 9, and 12; and column 6, lines 1-63. Such particles are always non-uniform in size. The exemplified amounts seem to meet claims 10-12. The PTMEG falls within the scope of the instant claims 15-16 and 18. Chain extension of the examples will give the limitation of the instant claim 21. The polyurethanes themselves are surfactants based on their HLBs which reads on the instant claims 22-23. The examples use catalyst of claim 24. The lower molecular weight prepolymers which are liquid by definition of viscosity average molecular weight are reactive diluents according to the instant claims 25-26 and the prepolymer is a "macromonomer" which is a monomer.

Art Unit: 1714

Ethylene diamine can give branching as can the reaction with water and NCO which gives the terminal amine group which reads on claim 28. The lower molecular weight prepolymer gives plasticizing by definition of viscosity average molecular weight. It is not seen that the core shell particles of the patentee do not also have the morphologies of the instant claims 33-37 and they are necessarily inherently expected to do so since they are otherwise the same mixtures as those of the instant claims.

7. Claims 14 and 48 are is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/733,027

Art Unit: 1714

Page 5



Patrick D. Niland
Primary Examiner
Art Unit 1714